

**REMARKS/ARGUMENTS**

The present amendment, amends claim 56 to make the language in the claim more consistent, and amends claim 33 to more clearly distinguish the claim over the '844 patent. Claims 61-65 are added as shown above. Claims 1-10 were previously canceled. Following this amendment claims 11-65 are pending in this application.

The 3/25/05 Office Action indicated that claims 19-21, 23-32 and 53-55 are allowed. The indication of allowability of these claims is much appreciated.

The 3/25/05 Office Action rejected claims 11-18, 22, 33-52 and 56-60 as being anticipated by Anderson et al. U.S. Patent No. 5,735,844 (the '844 patent). These rejections are respectfully traversed.

**Response to Rejection of Pending Independent Claim 11**

Pending independent claim 11 recites a device having a first planar surface, where the planar surface has a first area which is cooled by a cooling element, and a second area which defines an aperture through which radiation is emitted. It appears that the analysis which is provided in the 3/25/05 Office Action does not provide any discussion suggesting that the '844 patent discloses any type of planar surface such as that recited by claim 11. See, page 2 of the 3/25/05 Office Action. Indeed, a review of the '844 patent and specifically a review of Fig. 10B of the '844 patent, shows that the structure disclosed in the '844 patent is very different than that recited by claim 11. For ease of reference some of the language from claim 11 is shown below, with emphasis added:

**a body having a first planar surface which is placed against a patient's skin, the first planar surface includes a first area, and includes a second area which defines an aperture adjacent the first area;**

**a cooling element disposed in the body, said cooling element operating to cool the first area; and**

**a radiation source disposed in the body, the radiation source positioned to emit radiation through the aperture, whereby radiation energy is applied to the patient's skin.**

The Examiners attention is respectfully drawn to Figs. 3A, Fig. 4 and Fig. 8, of the pending application, as examples which show illustrative embodiments having a planar surface

34 which is cooled, and then provides another area of the planar surface which defines an area through which radiation is emitted. In contrast with the language of claim 11, Fig. 10B of the '844 patent shows a very different structure. The structure of Fig. 10B provides a slot 110 where lenses 116 are disposed on opposite sides of the slot. Cooling water is flowed through a cooling line 118 over the lenses to cool the lenses. The structure of the housing in Fig. 10B does not provide a planar surface even remotely similar to the planar surface recited by claim 11. Indeed it appears that the surface of the contact device 46' which is in contact with the skin is substantially curved and not planar. In light of the above it is respectfully submitted that claim 11 is not disclosed, or suggested by the '844 patent. Thus, it is submitted that claim 11, and its dependent claims are patentable over the '844 patent.

#### Response to Rejection of Pending Independent Claim 33

Pending independent claim 33 recites a device having a lens system which can be varied, and that the lens system is not in contact with the patient's skin. For ease of reference some of the language from claim 33 is shown below:

a body having a skin-contacting end;  
a skin-cooling element carried by the body and having a cooling surface at the skin-contacting end;  
a radiation source carried by the body and positioned to transmit tissue damaging radiation to a patient's skin;  
a lens system carried by the body, and wherein the lens system is positioned such that it is not in contact the patient's skin, and positioned between the light radiation source and the patient's skin, such that the tissue damaging radiation is transmitted through the lens system, prior to being incident on the patient's skin, wherein a focal length of the lens system can varied, whereby a size of a treatment area is varied by changing the focal length.

As shown in the 3/25/05 Office Action at page 3, the rejection of claim 33 was based in part on the discussion in the '844 patent at col. 6: line 10-20, which describes the contact device 46 as being formed into a lens having a focal length in the range of between about 0.5 to 2 cm. However, it is noted the '844 structure does not appear to provide for a lens system where the focal length can be varied; rather it appears that the '844 patent teaches that one should recognize that the surface shape should be controlled during fabrication, to control the light field 38'.

However, it appears that once the contact surface has been selected for a particular device, the surface can not then be varied to vary the size of the treatment area. In contrast, claim 33 specifically recites that the focal length of the lens system can be varied to change a size of the treatment area. Further, as amended above claim 33 now specifically recites that the lens system is positioned so as not to be in contact with the patient's skin which provides an additional significant distinction over the teaching of the '844 patent which provides that a lens is in contact with the patient's skin.

Thus, it is respectfully submitted that claim 33, and its dependent claims area patentable over the '844 patent.

**Response to Rejection of Pending Independent Claim 41**

Pending independent claim 41 recites a device which has among other elements a recessed window through which the radiation passes, and the window is spaced in a direction away from the patient's skin, and there is an open region between the skin and the recessed window to permit viewing of the skin under the window. The rejection in the Office Action appears to interpret Fig. 10B of the '844 patent as providing an air gap, or open region, which can be used for viewing, stating in part "since the lens 116 is transparent to light, the air gap can be used for viewing." Office Action, p. 3.

It is respectfully submitted that Fig. 10B of the '844 patent provides a cross-sectional view of a the device. See e.g., '844 Patent col. 4: lines 17-18. The device includes a contact device or applicator 46'. As discussed in the '844 patent at col. 10: lines 51-67, a slot 110 is formed in the applicator, and skin is drawn into the slot using a vacuum line 112 leading to the top of the slot, and the lenses 116 are on the sides of the slot 110. It is clear that the slot 110 is disposed in a center area of applicator. The applicator body surrounds the area being treated which is in contact with the lenses 116. The top of the skin pulled into the slot 110 appears to be totally enclosed in the slot, as are the lenses. Even if there might be some small gap between the top of the skin being pulled into slot by the vacuum line, this gap would be covered by the vacuum line, and the vacuum line is disposed in the body of the applicator. Thus, there appears to be no element of Fig. 10B which provides an open region for viewing the skin under a recessed window.

Thus, it is respectfully submitted that claim 41 and its dependent claims are patentable over the '844 patent.

#### **Response to Rejection of Pending Independent Claim 56**

Independent claim 56 is similar to claim 41 and recites in part:

- a body having a skin-contacting end;
- a skin-cooling element carried by the body and having a cooling surface at the skin-contacting end;
- the body having a recessed window through which tissue treating radiation passes to a patient's skin; and
- said recessed window being laterally offset from the cooling surface;
- said recessed window being spaced apart from the cooling surface in a direction away from the patient's skin when the cooling surface is contacting the patient's skin, such that an open region is created between the recessed window and an area of the patient's skin, and the open region provides a view port.

It is respectfully submitted that the cross sectional view shown in Fig. 10B of the '844 patent does not provide an open region which provides a view port. Indeed, if there is any gap between the top of the skin pulled into the slot 110 of Fig. 10B, the gap would be enclosed in the applicator 46' and under the vacuum line 112. Thus, this gap does not provide a view port, in that there would appear to be no way for one to view the area of skin which is sucked into the slot by the vacuum. Therefore, it is respectfully submitted that claim 56 and its dependent claims are patentable over the '844 patent.

#### **New Claims 61-65**

New independent claim 61 and its dependent claims are similar to claim 56 and its dependent claims, and are believed to be patentable for at least the same reasons as claim 56.

#### **Supplemental Information Disclosure Statement**

On December 21, 2004 a supplemental information disclosure statement was mailed to the USPTO in connection with this case. A copy of this IDS along with the PTO-1449 form and a post card indicating receipt by the USPTO is submitted herewith. It appears that a copy of the PTO-1449 form of the IDS, with the Examiner's indication of consideration of the references cited in the IDS was not provided with the 3/25/05 Office Action. It is respectfully requested

that the Examiner provide a copy of the PTO-1449 form with an indication of consideration of the references.

**Conclusion**

For the reasons set forth above, it is believed that all claims present in this application are patentably distinguished over the references, and in condition for allowance. Therefore, reconsideration is requested, and it is requested that this application be passed to allowance.

Respectfully submitted,

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